



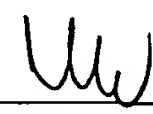
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/591,912	06/09/2000	Douglas Corning	SCHW-410	3491
28584	7590	12/01/2004	EXAMINER	
STALLMAN & POLLOCK LLP SUITE 2200 353 SACRAMENTO STREET SAN FRANCISCO, CA 94111			KARMIS, STEFANOS	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/591,912	<b>Applicant(s)</b> CORNING ET AL.	
	<b>Examiner</b> Stefano Karmis	<b>Art Unit</b> 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-14,16,17,19-21 and 38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-14,16,17,19-21 and 38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date <u>08/05/2004</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                                   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. This communication is in response to Applicants' amendment filed on 13 August 2004.

#### ***Status of Claims***

2. Claims 1, 3, 5, 14, 16 and 19-21 are currently amended. Claims 2, 4, 15, 18, 22-37 are cancelled. Claim 8 is previously presented. Claims 6, 7, 9-13, and 17 are originally filed. Therefore claims 1, 3, 5-14, 16, 17, 19-21 and 38 are under prosecution in this application.

#### ***Summary of this Office Action***

3. Applicant's arguments, filed 13 August 2004, with respect to the rejection(s) of claim(s) 1, 3, 5-14, 16, 17, 19-21 and 38 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made as discussed below and Applicant's request for allowance is respectfully declined.

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***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 3, 5-10, 12-14, 16, 17, 19-21 and 38 are rejected under 35 U.S.C. 102(e) as being anticipated by Matsumoto et al. (hereinafter Matsumoto) U.S. Patent 6,526,285.

Regarding independent claims 1 and 14, Matsumoto teaches a method for organizing a plurality of times which are being tracked in a personal organizer device of the type which is capable of exchanging information with a communications center comprising:

maintaining a data list in the personal organizer device, wherein the data list includes all of the plurality of items being tracked, wherein the plurality of items being tracked is limited to a predetermined number of items, and wherein maintaining the data list includes storing information received from the communications center in a memory of the personal organizer device for each item being tracked (column 11, lines 33-51 and column 23, lines 51-67);

including in the data list a category tag (such as electrical or construction) for each of the plurality of items being tracked (column 20, lines 62-67);

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displaying in a sublist associated with a designated category tag all of those items in the data list which have the designated category tag (column 21, lines 39-61);

providing at least two category tags for at least a first one of the plurality of items being tracked (column 25, lines 35-40);

displaying the first one of the plurality of items being tracked in a sublist according to the item being tracked (column 25, lines 11-48 and Figure 5);

and displaying the first one of the plurality of items being tracked in a second sublist associated with a second designated tag (column 25, lines 11-48 and Figure 5).

Claims 3 and 17, wherein a plurality of securities is included among the plurality of items being tracked (column 25, lines 11-48 and Figure 5).

Claims 5 and 16, wherein the personal organizer device is a hand held device (column 4, lines 36-61).

Claims 6 and 19, displaying a running total of the number of items in the data list (column 26, lines 38-61 and Figure 5).

Claims 7 and 20, displaying the maximum number of items in the data list (column 26, lines 38-61 and Figure 5).

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Claims 8 and 21, displaying the running total of the number of items in the data list, and the maximum number of items permitted in the data list (column 26, lines 38-61 and Figure 5).

Claim 9, the data maintaining step includes the step of adding new items to the plurality of items being tracked by way of entering an identifier for each new item (column 21, lines 9-38).

Claim 10, the new item adding step includes the step of supplying a category tag for each new item (column 21, lines 9-38).

Claims 12-13, the displaying step includes the step of including selected information about the items being displayed in the sublist which information includes information received from the communications center and displaying the data list (column 26, lines 38-61 and Figure 5).

Regarding independent claim 38, Matsumoto discloses a method for organizing information for a plurality of securities which are being tracked in a hand held computing device of the type which is capable of exchanging information with a communication center comprising:

maintaining a data list in the hand held computing device, which includes information of all of the plurality of items being tracked (column 11, lines 33-51 and column 23, lines 51-67);

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transmitting information for all of the plurality of securities being tracked from the communication center to the hand held computing device over a wireless link (column 43, lines 49-64);

including in the data list at least one category tag for each of the plurality of the securities being tracked (column 20, lines 62-67) wherein a division is specified;

for at least a first one of the securities being tracked providing at least two category tags (column 25, lines 36-40) wherein the stock may belong to a plurality of industry divisions;

and displaying in a sublist associated with a designated category tag all of those securities in the data list which have the designated category tag, wherein the first security which has at least two different category tags, will be displayed in at least two different sublists of securities based on the at least two category tags provided for the first security (column 25, lines 11-48 and Figure 5).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto U.S. Patent 6,526,285.

Claim 11, Matsumoto teaches the number of items being tracked is limited to a certain number based on space available in the memory of the personal organizer device (column 26, lines 38-67). Matsumoto fails to teach that user must delete at least a selected one of the plurality of items being tracked whenever the number of items being tracked will exceed a predetermined limit number because of the addition of the new item. Official Notice is taken that adding and deleting from a list is old and well known in the computer arts. Therefore it would have been obvious at the time of the Applicants' invention to require the deletion of an item if new items are to be added to a list that is constrained by memory because it needs free space in order to add to the list.



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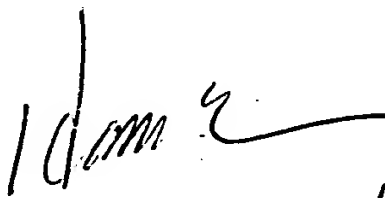
***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (703) 305-8130. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully Submitted  
Stefano Karmis  
24 November 2004

  
**HANI M. KAZIMI**  
**PRIMARY EXAMINER**